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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/510,580	02/22/2000	Richard A. Leeds	59622-2	4232

22504 7590 11/28/2007

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EXAMINER	
VIG, NARESH	
ART UNIT	**PAPER NUMBER**
3629	

MAIL DATE	DELIVERY MODE
11/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/510,580	LEEDS, RICHARD A.	
	Examiner	Art Unit	
	Naresh Vig	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *67 – 75 and 92 – 98* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *67 – 75 and 92 – 98* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This is in reference to communication received 24 September 2007. Claims 67 – 75 and 92 – 98 are pending for examination.

Response to Arguments

In response to applicant's argument that the disclosure filed 22 February 2000 discloses that a "shopper using a computer with a Domain Name System (DNS) entry in New York vs. Washington vs. Colorado entering the same domain name to access may also receive different displayed information." P. 4, In. 27 to P. 5, In. 1.

However, specification as filed does not enable one of ordinary skill in the art to use the invention. Applicant's invention is directed to merchandise based on shopper's entry point which uses shopper's web navigation and cookie [see disclosure page 6, pp4 – page 7, pp1] which is different that what applicant is currently claiming as their invention.

In response to applicant's argument that while IP addresses do not contain any geographic information and are assigned without regard to geographic location, at the time the application was filed, several methods of determining the location would have been available to and known by one of ordinary skill. In other words, if asked to determine the location of a remote system based on its IP address, would one of

ordinary skill in the art at the time the application was filed (February 22, 2000) have known how to make that determination using any one of the following exemplary tools.

However, the disclosure filed 22 February 2000 would require undue experimentation to use the invention. For example, 9.0.0.0 is the address assigned to IBM Corporation. Data directed to 9.b.c.d is forwarded to IBM who routes the data to appropriate destination. How IBM has implemented their network is known to IBM and not one of ordinary skill in the art as the time of invention.

In response to applicant's argument the domain name system ("DNS") is fundamental to the transfer of information across the Internet. The DNS includes name servers that map each domain name to an IP address. Whenever a user (such as the shopper) enters a domain address, one or more name servers are queried to determine the IP address of the host system associated with the domain name. "[I]nverse inquires [in which an IP address is presented to the DNS system] have been part of the domain system since it was first specified .... " Douglas E. Comer, Internetworking with TCP/IP Vol 1: Principles, Protocols, and Architecture, 329-331 (2nd Ed. 1991). This reference also explains how to formulate a "pointer query" to determine the domain name associated with an IP SEA 2085010vl 0059622-000002 Seattle address. As this was known for at least ten years before the filing of the present application, it was surely known by one of ordinary skill in the art who is presumed to have knowledge of the prior art. Therefore, using only the IP address, one of ordinary skill would have known how to obtain the domain name associated with that IP address.

However, the example cited by the applicant is directed to finding domain name of the machine specified with the IP address in the Domain Name Server. However, it would have been obvious to one of ordinary skill in the art that customer devices are not registered with the Domain Name Servers which require static IP address to be able to provide proper Domain Name associated with the IP address.

In response to applicant's argument that the attached A Primer on Intemet and TCP/IP Tools, published in 1994, describes a tool named "nslookup" which may be used to perform the inverse DNS lookup. G. Kessler and S. Shepard, A Primer on Internet and TCP/IP Tools, Request for Comment (RFC) No. 1739, The Internet Engineering Task Force, Networking Working Group (December 1994). In addition applicant is using traceroute tool.

However, book by Douglas Comer, traceroute and nslookup tool is an evidence that the applicant has kept these tools as a secret and not disclosing the tools to enable one of ordinary skill in the art to use the invention. As currently disclosed by the applicant, it would require one skilled in the art to use the invention.

In response to applicant's argument another exemplary method involves looking up the IP address in the American Registry for Internet Numbers ("ARIN") database. ARIN was established in 1997 as one of five regional internet registries for IP addresses (not domain names). ARIN's service region includes the United States. At the time the application was filed, the ARIN database could be queried for information related to the

owner of an IP address. An online version can be viewed today at http://www.arin.net/index.shtml. As explained in applicant's May 30, 2006 response to Examiner's request for information under 37 CFR 1.105, a search of the network name portion of the IP address 24.127.74.33, which is 24.127.0.1, indicated the network was located in Los Angeles. However, applicant notes that the ARIN database now indicates the location of the network is Richmond. Applicant invites the examiner to visit the ARIN website and enter the IP address of the exemplary remote computer and/or its network to view the results of such a query.

However, knowing owner of an IP address does not necessary means knowing location of the customer. As known to one of ordinary skill in the art at the time of invention, service providers like Comcast owns IP address and dynamically assigns IP address to their subscribers. Also, this is another example that applicant has kept these tools as a secret and not disclosing the tools to enable one of ordinary skill in the art to use the invention. As currently disclosed by the applicant, it would require one skilled in the art to use the invention.

In response to applicant's argument cited references Bandera et al. in view of Griffiths et al. does not mention the location of the shopper's computer at the time of the current communication, as determined by the shopper data collector, is used by the shopper data collector to determine for the current communication particular traits, habits, or interests of the shopper or other pertinent shopper information. Griffiths does not mention using the location of the user for any purpose and Bandera et al. discusses

adapting the advertisements based only on location, and time, user traits, habits, and interests are never discussed. Therefore, neither reference nor a combination thereof renders the invention of claim 72 obvious.

However, cited reference teaches systems, methods and computer program products for selecting an advertising object to be displayed within a web page requested by a user based on the geographic location of the user and/or on the time of day. The web server selects an advertising object based upon the user's location and/or the time of day the web page request is received.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 67 – 75 and 92 – 98 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant is arguing and claiming reverse engineering to determine user location as their claimed invention which is also noted in the interview summary mailed 19 April

2007. Specification originally filed 22 February 2000 does not have support to enable one of ordinary skill in the art to use applicant's claimed and argued invention to use DNS to determine current location of the user.

Applicant has filed an affidavit with evidence on 24 September 2007 to support their argument that the disclosure filed 22 February 2007 is adequate to enable one of ordinary skill in the art to implement the invention. However, the evidence presented with the affidavit is not persuasive because it would require undue experimentation by one of ordinary skill in the art on how the applicant would have enabled them to use the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 67 – 75 and 92 – 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera et al. US Patent 6,332,127 hereinafter known as Bandera in view of Griffiths et al. US Patent 6,28,6045 hereinafter known as Griffiths.

Regarding claims 67 and 92, As best understood by examiner, Bandera teaches system for selecting an advertising object to be displayed within a web page requested by a user based on the geographic location of the user and/or on the time of day. Bandera teaches merchandise or service database; a shopper data collector configured to collect and analyze data from the remote computers of shoppers to determine information usable to formulate tailored store screens for shoppers; a presentation formulator configured to formulate store screens to be displayed on the shopper's computer during the current communication; and a web server configured to communicate with the remote computers of shoppers and to send the tailored store screens to the remote computers.

Bandera does not explicitly teach a presentation formulator configured to formulate tailored store screens to be displayed on the remote computers of shoppers. However, Griffiths teaches that it is old an known to create and send tailored store screens to be displayed on the remote computers of users.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bandera as taught by Griffiths to to enhance the efficacy of advertising to users accessing the web.

Regarding claim 68 – 71, Bandera in view of Griffiths teaches capability wherein the data collected and analyzed by the shopper data collector from the shopper's computer during the current communication includes the search request the shopper entered into the shopper's computer to navigate to the host system to initiate the current

communication, without the host system requiring the shopper to take any direct action to instruct the shopper's computer to provide such information to the host system and without the host system having such information prior to the current communication, and wherein the one or more tailored store screens to be displayed on the shopper's computer during the current communication are formulated by the presentation formulator by including and excluding selected information in at least one of the merchandise database and the services database at least in part upon the search request the shopper entered into the shopper's computer to navigate to the host system to initiate the current communication, the prior web site from which the shopper navigated to the host system to initiate the current communication and the software installed on the shopper's computer at the time of the current communication, as determined by the shopper data collector.

Regarding claim 72, Bandera in view of Griffiths teaches capability wherein the location of the shopper's computer at the time of the current communication, as determined by the shopper data collector, is used by the shopper data collector to determine for the current communication particular traits, habits, or interests of the shopper or other pertinent shopper information, then used by the presentation formulator to formulate the one or more tailored store screens to be displayed on the shopper's computer during the current communication.

Regarding claim 73, Bandera in view of Griffiths teaches capability wherein presentation formulator formulates the one or more tailored store screens to be displayed on the shopper's computer during the current communication to contain at least one of a direct response advertisement area and an impulse advertisement area, containing information on at least one of merchandise and services related at least in part to the location of the shopper's computer at the time of the current communication, as determined by the shopper data collector.

Regarding claims 74 – 75, Bandera in view of Griffiths teaches capability wherein location of the shopper's computer at the time of the current communication is determined using a publicly accessible database like Domain Naming System.

Regarding claims 93 – 96, Bandera in view of Griffiths teaches capability to determine additional information about the computer by reading the additional information from a publicly accessible database like Domain Name System (DNS).

Regarding claim 97, Bandera in view of Griffiths teaches capability to determine geographical location of the computer as the additional information about the computer.

Regarding claim 98, Bandera in view of Griffiths teaches capability to send the at least one tailored screen to the computer via the network during the current communication session.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant is required under 37 CRF '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Naresh Vig
Examiner
Art Unit 3629

November 25, 2007